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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,172	01/29/2001	John L. Cartier	29026-P01	9721

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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/772,172

Applicant(s)

CARTIER, JOHN L.

Examiner

Victor S Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 2/28/2005 and 1/7/2005. Applicants' amendments to the specification, cancellation of claims 1-10, and new claims 11-15 have been entered. Since claim 11 has been previously cancelled (see amendment filed 2/17/2004), the new claims are now renumbered as claims 12-16 in the same order as submitted.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn. In particular, it is noted that new claims substantially modifies the scope of the invention, and overcome the rejection under 35 USC 102(b) over Onderak individually. However, a new search is required for newly added elements, and Applicants' arguments are moot in view of the new grounds of rejection.

Drawings

4. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the replacement drawings submitted on 2/28/2005 lack numerals to identify corresponding elements in the newly amended specification. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The

corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 12-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

More particularly, the following elements appear to be new matter:

In claim 12, line 8: the term "snug".

In claim 12, line 10: the term "dark".

In claim 12, line 10: the term "finely textured".

In claim 12, line 11: the terms "entire" and "reversible".

In claim 14, line 1: the term "black".

In claim 15, line 2, the phrase "urethane foam".

The Examiner notes that Applicant fails to point out any express support in the specification for above-listed elements, nor does the Examiner find them to be

inherently disclosed. In the next reply, Applicant is required to either provide supports for these elements, or cancel the new matter.

7. Claims 12-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

More particularly, in claim 12, line 10, the term "finely textured", in addition to being a possible new matter, as set forth above, also appears to be vague and indefinite, because there is no recitation in the claim or specification regarding the physical features for this term, as such they fail to give a clear notice as to what constitutes infringement upon the instantly claimed invention.

Rejections Based on Prior Art

8. Claims 12, 14, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onderak et al. (US 4403009) in view of DE 19607523A (Derwent abstract) and Cooke et al. (US 6479571).

First, the Examiner restates the relied upon prior art reference as follows: Onderak's invention is directed to a skid resistance resilient floor covering which provides a comfortable cushioning action for the user (abstract). In Fig. 4, Onderak shows that the floor covering comprises a wear layer 52, a foam layer 54, and a bottom layer 58. The floor covering can be made in a specific pattern from specifically defined sections of the material of the invention, i.e., the floor covering can be made of the width, length and configuration of the area involved (column 1, lines 21-31). The wear

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layer 52 is formed of a polyvinyl chloride (PVC) resin, and may contain pigments to the desired color (column 2, lines 10-14). The wear layer is in the form of a flat piece of material joined with the foam layer to form a mat (column 2, lines 25-29). A PVC bottom layer 58 provides a uniform backing (column 4, lines 28-42; column 5, lines 26-30). The edge outline of the mat is heat sealed under vacuum (i.e., snug, airtight and waterproofed) (column 3, lines 55-57; column 6, lines 45-46).

For claims 12 and 14, Onderak is silent about the compressibility of the resilient floor covering mat in sub-freezing temperatures. However, since Onderak teaches the same PVC wear layer and the same polyurethane foam core, in the absence of evidence to the contrary, it is the Examiner's position that the compressibility in sub-freezing temperatures of Onderak's floor mat is either inherently the same, or obviously provided, once the same material is selected. Additionally, Onderak lacks an express teaching that the mat is reversible. However, it is noted that DE '523 describes a resilient floor covering mat. The mat has outer coatings over a substrate in the middle. When the walking side is worn out, the flooring can be turned over to provide a long use life (abstract). As such, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art to modify Onderak's floor covering may with the same PVC wear layer on both sides of a PU foam core layer, as taught by DE '523, motivated by the desire to obtain a long lasting floor covering mat. Regarding the product-by-process recitation "cover folded in half ... core being positioned within said folded cover ... being sealed to each other", the Examiner notes that a process limitation must be evidenced as effecting the structure or chemistry of the resultant

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product over the prior art. Since the method limitations have not been shown on the record to produce a patentably distinct article, the formed articles are rendered *prima facie* obvious. See MPEP § 2113. Regarding the term “dark”, in addition to being a possible new matter, as set forth above, the Examiner notes that Onderak does teach that may contain pigments to the desired color; further, it is noted Cooke’s invention is directed to polymeric products containing modified carbon products for improving properties (abstract). Cooke teaches that the suitable polymers include PVC (column 9, lines 21-41), and modified carbon black products can impart improved abrasion resistance (column 17, lines 1-5). As such, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art to modify the PVC wear layer of Onderak with a modified carbon black, as taught by Cooke, motivated by the desire to improve the abrasion resistance of the wear layer. It should be noted that carbon black is inherently a dark colored pigment. Regarding the term “finely textured”, the Examiner notes that Onderak does teach a skid resistant textured wear layer as shown in Figs 1 and 4. Since no physical features are present in the instant claims defining what constitutes “finely textured” so as to exclude the applied art from the scope thereof, it is the Examiner’s position that the texture in the prior art floor covering serves to meet the vague and indefinite claim limitation as claimed. Finally, regarding the use limitation at the end of claim 12 “whereby when ice ... to facilitate removal thereof from the mat”, the Examiner notes that since the use limitation does not structurally or compositionally effect the floor covering, they are irrelevant to the patentability of the instant invention.

For claim 15, Onderak expressly teaches that suitable polymers for the foam layer include polyurethane (PU), etc. (column 2, lines 15-17).

For claim 16, Onderak expressly teaches that the bottom layer may be easily bonded with adhesives to the floor of the installation area (column 4, lines 28-42; column 5, lines 26-30).

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Onderak et al. (US 4403009) in view of DE 19607523A (Derwent abstract) and Cooke et al. (US 6479571), and further in view of Kerr et al. (US 6340514).

The teachings of Onderak, DE '523 and Cooke are again relied upon as set forth above.

For claim 13, Onderak lacks a teaching that an adhesive coating is used to secure the foam core layer to cover layer. However, it is noted that Kerr's invention is directed to a cushioned mat. Kerr teaches that a resilient mat having an adhesive layer between a foam core layer and cover sheet provides strength of overall structure, and shape retention upon continued pedestrian use (column 2, lines 10-16). As such, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art to modify Onderak's mat by incorporating a layer of adhesive between the foam core and wear layer, as taught by Kerr, motivated by the desire to obtain strength of overall structure, and shape retention upon continued pedestrian use. Finally, regarding the product-by-process recitation "is coated ...", the Examiner again notes that a process limitation must be evidenced as effecting the structure or chemistry of the resultant product over the prior art. Since the method limitations have not been shown on the

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record to produce a patentably distinct article, the formed articles are rendered *prima facie* obvious. See MPEP § 2113.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Victor S Chang
Examiner
Art Unit 1771

4/1/2005